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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,098	10/27/2000	Frederick S. M. Herz	0635MH-40874	7141

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EXAMINER

MAHMOUDI, HASSAN

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/699,098

Applicant(s)

HERZ ET AL.

Examiner

Tony Mahmoudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Remarks

1. In response to communications filed on 19-May-2005, claims 3-12 is presently pending in the application, of which, claim 1 is presented in independent form.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 3-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowman-Amuah (U.S. Patent No. 6,697,824 B1.)

As to claim 3, Bowman-Amuah teaches a method of allowing access to data over a distributed data processing system (see Abstract, and see column 22, lines 63-67), comprising:

(a) providing an automated infrastructure for the exchange of information between multiple self-interested parties (see column 25, lines 6-11, and see column 26, lines 12-29);

(b) providing a trusted server (see column 72, lines 44-64) with at least one data warehouse for the storage of the information (see column 74, lines 18-30);

(c) associating a price rule with particular data records of the information which establishes a cost of accessing the particular data records, and which controls the access to that data (see column 27, lines 22-53, see column 61, line 28 through column 62, line 5, and see column 78, line 56 through column 79, line 25);

(d) wherein the price rule enables a data owner associated with the data to specify a different price for different types and amounts of information access (see column 61, line 28 through column 62, line 5);

(e) within the trusted server, providing a data processing platform which is accessible to multiple third-party data processing software programs which operate as software agents (see column 42, line 65 through column 43, line 4, and see column 47, line 12 through column 48, line 9);

(f) wherein a plurality of seller-side software agents have defined relationships to the price rules and associated data records, and maintain absolute access control to the data records (see column 26, lines 30-40, see column 31, lines 17-23, and see column 34, lines 6-22);

(g) wherein a plurality of buyer-side software agents have regulated query access to the data processing platform and may request pricing information from the seller-side software agents (see column 36, lines 7-46, and see column 52, lines 22-45);

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(h) wherein the plurality of seller-side software agents and the plurality of buyer-side software agents operate as persistent data processing systems which interact with one another repeatedly over time and which thus define a virtual marketplace (see column 26, lines 42-56, see column 28, line 65 through column 29, line 11, and see column 38, lines 58-67.)

As to claim 4, Bowman-Amuah teaches wherein the trusted server is accessed via a network (see column 72, lines 45-64.)

As to claim 5, Bowman-Amuah teaches wherein the network is a wireless network (see column 20, line 62 through column 21, line 9.)

As to claim 6, Bowman-Amuah teaches wherein the network is a cellular network (see column 20, line 62 through column 21, line 9.)

As to claim 7, Bowman-Amuah teaches wherein the network is the Internet (see figure 33, and see column 74, lines 19-30.)

As to claim 8, Bowman-Amuah teaches wherein the software agents are associated with at least one individual (see column 28, line 53 through column 29, line 11.)

As to claim 9, Bowman-Amuah teaches wherein the software agents are associated with at least one company (see column 26, lines 31-40.)

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As to claim 10, Bowman-Amuah teaches wherein the cost of accessing the particular data records is the price that the buyer-side software agents must pay before accessing the particular data records (see column 79, lines 11-16.)

As to claim 11, Bowman-Amuah teaches wherein the information access is encrypted through the use of a security certificate (see column 45, lines 15-25, see column 62, lines 14-17, and see column 81, line 37 through column 82, line 39.)

As to claim 12, Bowman-Amuah teaches wherein the security certificate is managed by a public key infrastructure (see column 71, lines 1-37.)

Response to Arguments

4. The declaration filed on 19-May-2005 has been considered but is ineffective to overcome the Bowman-Amuah reference (US 6,697,824 B1.)

Based on the evidence supplied, it appears that the applicant is relying on conception prior to the effective date of the reference, followed by diligence until the US filing date.

The submitted evidence is insufficient to establish a conception of the invention prior to the effective date of the Bowman-Amuah reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a

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complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interactions must also be comprehended.

See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Per MPEP 715.07:

The essential thing to be shown under **37 CFR 1.131** is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883).

Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy **37 CFR 1.131**.

when reviewing a **37 CFR 1.131** affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of **37 CFR 1.131(b)**. *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

Per MPEP 715.07(a):

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

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In determining the sufficiency of a **37 CFR 1.131** affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

5. In view of the above examples and the requirements set forth by the MPEP, the examiner is maintaining the validity of the reference(s) cited in the previous and the present Office Actions as appropriate "prior art" to the claims of the present invention.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

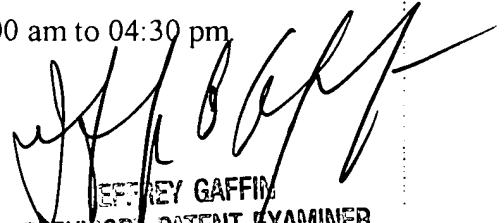
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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7. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (571) 272-4078. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm

tm

July 27, 2005


JEFFREY GAFFIN
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